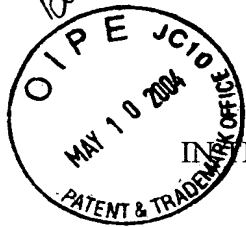


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Group: 2831
Confirmation No.: 7528
Application No.: 09/982,154
Invention: HIGH VOLTAGE CABLE
Applicant: Brian E. Gorrell
Filed: October 18, 2001
Attorney
Docket: 3030-69081
Examiner: William H. Mayo III

Certificate Under 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

on May 7, 2004
Kim Tyree
(Signature)

Kim Tyree
(Printed Name)

REPLY BRIEF

Mail Stop Appeal Brief
Commissioner for Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This reply brief is submitted in triplicate in response to the Examiner's answer mailed March 25, 2004. The Commissioner is hereby authorized to charge any fees which may be necessary in connection with the filing of this reply brief to Appellant's undersigned counsel's deposit account 10-0435, with reference to file number 3030-69081. A duplicate copy of this authorization is enclosed for this purpose.

The Examiner takes the position that Appellant's statement that certain claims are independently patentable is incorrect. The Examiner's rationale for this position is that the Examiner rejected all of the claims based upon the same combination of references. The test for determining whether claims are independently patentable doesn't depend upon the Examiner's reasons for rejection, or the combination of references relied upon by the Examiner to support rejection. Whether claims are independently patentable depends upon

what the claims say, not upon the Examiner's rationale for rejecting them. The content of the claims was the focus of Appellant's statement that the claims are independently patentable, and was the focus of Appellant's argument in support of that position. Appellant's reasoning is summarized beginning at page 2 of the appeal brief under the heading "Summary of the Invention," and explained in considerable detail beginning on page 15 of the appeal brief and continuing through page 42 thereof. The Board is referred to the appeal brief for that reasoning. Appellant's position remains that the claims are separately patentable, at least for the reasons stated at these locations in the appeal brief.

The Examiner fairly succinctly states Appellant's arguments, namely: 1) the prior art relied upon by the Examiner discloses a number of different combinations of various ones of the elements claimed in Appellant's claims, no individual one of those combinations meeting Appellant's claims; and, 2) the Examiner has engaged in impermissible hindsight reconstruction of elements by picking and choosing from among the elements he believes he has found in the various prior art references, guided only by Appellant's own disclosure.

The Examiner's justification that any judgment of obviousness involves hindsight reconstruction clearly is of little comfort to Appellant.

The Examiner concedes that

"Dinzen teaches a lot of different [cable] configurations and materials (i. e., species of the invention) that may be utilized in cable, however the fact remains that Dinzen clearly teaches that the high voltage cable having the dual conductive layer between the insulation layer and the jacket layer configuration, is well known in the art of cables."

The Examiner essentially quotes the following passage from Dinzen to support his position:

"As conventional the inner conductor is concentrically surrounded by an inner conducting sleeve 2 of semi-conducting rubber with the diameter of 5 mm, a high voltage insulation 3 of EPR (ethylene-propylene rubber) with a diameter of 15 mm, an outer conducting sleeve 4 of semiconducting rubber, an outer conductor 5 of braided copper wires with 95% covering, and an outer casing 6 of PVC with a diameter of 19 mm."

Dinzen, col. 4, lines 41-49.

The Examiner concludes from this quote that

"[T]he fact that Dinzen discloses an abundance of species in which his claimed invention can be configured utilizing different materials, does not detract (sic) from the suggestion to one of ordinary skill in the art. Based, (sic) on the teaching

of Dinzen, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the cable configuration of Hastings to comprise a third layer of conductive polymer material extending between the second layer of insulative material and a fourth layer of braided material wherein the fourth layer of braided shield is made as a copper braided shield as taught by Dinzen because Dinzen teach that such a configuration is a conventional high voltage cable configuration and provides for carrying high voltages without damaging the cable itself (Col. 1, lines 7-13) and it appears that Hastings '827 would perform the task of providing protection of the high voltage cable equally well with or without the modification of the known cable of Dinzen."

One would naturally ask, if it is true, as the Examiner concedes, "that Hastings '827 would perform the task of providing protection of the high voltage cable equally well with or without the modification of the known cable of Dinzen," then why would a person of ordinary skill have been motivated to modify Hastings '827 with these isolated teachings from Dinzen as the Examiner has proposed? The answer of course is that without the roadmap provided by Appellant's claims, a person of ordinary skill would not have been motivated to combine Dinzen with Hastings '827.

The Examiner continues:

"Thirdly, it has been held that if a species (configuration) is clearly named, the species claim is anticipated no matter how many other species are additionally named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990) (The claimed compound was named in a reference which also disclosed 45 other compounds. Specifically, the Board has held that the comprehensiveness of the listing did not negate the fact that the compound claimed was specifically taught. The Board compared the facts to the situation in which the compound was found in the Merck Index, saying that 'the tenth edition of the Merck Index lists ten thousand compounds. In our view, each and every one of those compounds is described, as that term is used in 35 U. S. C. § 102(a), in that publication.') Id. at 1718. See also In re Sivaramakrishnan, 673 F.2d 1383, 213 USPQ 441 (CCPA 1982) (The claims were directed to polycarbonate containing cadmium laurate as an additive. The court upheld the Board's finding that a reference specifically naming cadmium laurate as an additive amongst a list of many suitable salts in polycarbonate resin anticipated the claims. The applicant had argued that cadmium laurate was only disclosed as representative of the salts and was expected to have the same properties as the other salts listed while, as shown in the application, cadmium laurate had unexpected properties. The court held that it did not matter that the salt was not disclosed as being preferred, the reference still anticipated the claims and

because the claim was anticipated, the unexpected properties were immaterial.) Therefore, the examiner respectfully submits that the rejection is proper and within the standard of 35 U. S. C. § 103.”

Of course, for this argument advanced by the Examiner even to be applicable to the situation here presented to the Board, the rejection here would have to be a 35 U. S. C. § 102 rejection. That is, one of the species of Appellant’s claimed arrangement would have to have been present in the prior art. But the rejection in the present case is not a 35 U. S. C. § 102 rejection. It is a 35 U. S. C. § 103 rejection. Therefore, Examiner has already admitted by his rejection that the argument he is advancing, and the case law upon which he relies, are inapplicable to the issues before the Board. No species of Appellant’s claimed arrangement exists in the cited prior art. The only way a species of Appellant’s claimed arrangement exists is through the combinations of Hastings ‘827, Dinzen and Hastings ‘935. Appellant’s argument is that the combinations would not have rendered Appellant’s claims 1-20 35 U. S. C. § 103 obvious. The Board doesn’t even need to address the Examiner’s genus/species argument or analysis. No species of Appellant’s claimed arrangement exists in the cited prior art. Otherwise, the Examiner would not have needed Dinzen to supplement the teachings of Hastings ‘827, or would not have needed the teachings of Hastings ‘827 to supplement the teachings of Dinzen, or would not have needed Hastings ‘935 to supplement the teachings of Hastings ‘827/Dinzen, or would not have needed Hastings ‘827/Dinzen to supplement the teachings of Hastings ‘935.

What the Examiner’s characterizes as Appellant’s second argument, namely, whether the combination of Hastings ‘827 and Dinzen and the combination of Hastings ‘827, Dinzen and Hastings ‘935 meet the requirements to make out a prima facie case of 35 U. S. C. § 103 obviousness, was addressed in the appeal brief and the Board is referred to the appeal brief for that argument.

Summary and Conclusion

Again, by Appellant's rough calculations, there are seventy-two hundred different high voltage cable configurations that can be made up from among the cables taught by Hastings '827, Dinzen and Hastings '935. Appellant submits that it is the antithesis of 35 U. S. C. § 103 obviousness to arrive at the combinations claimed in Appellant's claims 1-20 from the combinations described in Hastings '827, Dinzen and Hastings '935.

Accordingly, Appellant submits that the final rejection of his claims 1-20 is erroneous and should be reversed. Such action is respectfully requested.

Respectfully submitted,



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